

REMARKS

The above preliminary amendments and following remarks are submitted in accordance with a Request for Continued Examination filed on even date and in response to the Final Official Action of the Examiner mailed on July 12, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has rejected claims 1, 6, and 11-24 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,583,561, issued to Baker et al (hereinafter referred to as "Baker"). This rejection is respectfully traversed as to the amended claims for the following reasons.

The standard for a finding of anticipated is found in MPEP 2131 which provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

Baker does not anticipate claims 1, 6, and 11-24, because "each and every element as set forth in the claim[s] is [not] found" in Baker as required by MPEP 2131.

With regard to claim 1, for example, claim element c requires that the "transaction server spools said different video

on demand programs from said data base storage to said temporary video storage memory" and claim element d requires that "said plurality of video servers....stream said spooled different video on demand programs from said temporary video storage memory to said plurality of subscriber receivers". In other words, claim 1 requires that "spooling" is accomplished by the "transaction server" and that "streaming" is accomplished by the "plurality of video servers".

In Baker, both of these functions are accomplished by the same entity, "video server 12". In the claimed invention, both the "transaction server" (i.e., "spooling") and the "plurality of video servers" (i.e., "streaming") handle video information. In Baker, all video information is handled by "video server 12". The Examiner continues to read the claimed "transaction server" element on to "control server" 54 of Baker. Though both the claimed "transaction server" and "control server" 54 of Baker can handle subscriber requests, "control server" 54 of Baker cannot handle video data.

Apparently, the Examiner recognizes this distinction. In his response to Applicants' previous arguments, the Examiner states:

Likewise, claim 1 requires that the server spools the programs from the database storage to video storage memory, there is no mention of direct access in claims 1 and 6 as argued by application.

It is exceedingly difficult to understand why the Examiner tends

to equate "direct coupling" with the function of "spooling". Nevertheless, independent claims 1, 6, 11, 16, and 21 have been herein amended to address this problem, even if not well understood.

In stating his position at page 2 of the pending official action, the Examiner further states:

As the control server 54 of Baker coordinates, controls and administers he access of the video servers 12 to the database storage via the application software (column 10, lines 29-36, 64-column 11, line 21), control server 54 spools the data from the database storage to temporary video storage memory as required by claim 1.

This statement is both logically incorrect and clearly erroneous. It is logically incorrect in that it suggests that if "control server" 54 of Baker "coordinates, controls, and administers" the claimed "spooling", it performs "spooling". This suggestion is logically incorrect on its face.

Furthermore, the statement on which the Examiner relies is clearly erroneous. He cites Baker, column 10, lines 29-36, and column 10, line 64, through column 11, line 21. The software of Fig. 4 and discussed at column 10, line 64 et seq., is located within "video server" 12 of Baker (see column 5, lines 59-61, and column 10, lines 64-65). In accordance with the teachings of Baker, "video server" 12 both performs spooling and "coordinates, controls, and administers" spooling. The Examiner's implication of "control server" 54 involvement is clearly erroneous.

The error of the Examiner's position can be further understood by the nature of his rejection. Claim 1 has four improvement elements. The Examiner reads each of these claims onto "video server" 12 of Baker. The Examiner finds:

1. A data base storage system 10 (video server 12....;
2. A temporary video storage memory 38....;
3. A transaction server 54 responsively coupled to said data base storage system 12.....(column 7, lines 45-65...; and
4. A plurality of video servers 12.....

Thus, the Examiner finds video server 12 to be a portion of the claimed "data base storage system". The Examiner finds "main storage unit" 38 of video server 12 to be the claimed "temporary video storage memory". The Examiner finds the functionality of video server 12¹ to be the claimed "transaction server". And the Examiner finds video server 12 to be the claimed "plurality of video servers". Surely, the Examiner can distinguish between the claimed architecture and the architecture disclosed by Baker.

Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

In rejecting independent claim 6, the Examiner makes a similar clearly erroneous finding of fact. He states:

¹Column 7, lines 44-46, states: "Video Library application software executing under the control of the operating system in the Video Server 12....".

A transaction server 54 (column 10, lines 37-64) responsively coupled to said data base storage system 12 and said plurality of subscriber receivers 22, capable of receiving said plurality of service requests, accessing said plurality of video programs corresponding to the server requests from said database storage system (column 7, lines 45-55, column 9, line 3; 54-58);

This finding is clearly erroneous, because control server 54 of Baker cannot access the video programs from the database storage system. Only Video Server 12 can perform such access (see Fig. 1). Furthermore, main storage unit 38 is located within video server 12 (see Fig. 2), and therefore cannot be directly accessed by control server 54. In addition, the cited functionality of column 7, lines 45-55; column 9, line 9; and column, lines 54-58, is all accomplished within "video server" 12, wherein Fig. 2 shows the internal hardware of "video server" 12² and Fig. 3 shows the software of "video server" 12³.

To assist the Examiner with his concern about "direct coupling", claim 6 has been amended in accordance with his suggestion. Therefore, the rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 11 is an independent apparatus claim having "means-plus-function" limitations. It requires separate and distinctive "temporarily storing means", "spooling means", and "streaming

²See column 5, lines 55-56.

³See column 5, lines 59-61.

means". These elements are all incorporated within a single entity, video server 12, of Baker. Fig. 2 shows that main memory unit 38, which the Examiner has found to be the "spooling means" is a part of video server 12. Similarly, "streaming" is performed by video server 12. Even though the Examiner somehow finds network interface 18 to be a "streaming means", he cites column 10, lines 40-44, which clearly shows that video server 12 performs the "streaming" function. As with the other independent claims, claim 11 has been amended above to provide the "direct" coupling suggested by the Examiner.

The rejection of amended claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and further limits the "generating means". Because Baker does not anticipate claim 11 from which claim 12 depends, it cannot anticipate claim 12 which is further limited by unique limitations. The rejection of claim 12 is respectfully traversed.

Claim 13 depends from claim 12 and further limits the "identifying means" which the Examiner, in making his rejection of claim 11, has found to be control server 54 of Baker. Therefore, the suggestion by the Examiner that video server 12 "acts as a transaction gateway" by citing column 7, lines 28-55, Fig. 4, and column 10 lines 56 through column 11, line 22. is legally irrelevant. Furthermore, in rejecting claim 2, the

Examiner explicitly admits that "Baker does not disclose a transaction gateway.....". The rejection of claim 13 is respectfully traversed for improper application of controlling law.

Claim 14 depends from claim 13 and further limits the "identifying means". In making his rejection, the Examiner confusing states:

Regarding claim 14, Baker discloses that video server 54 processes subscriber transactions (column 10, lines 54-64). (emphasis added)

This statement is confusing, because Baker has no "video server 54". To the extent, the Examiner really means "control server 54", his finding is clearly erroneous and unsupported by the citation, which ascribes the claimed functionality to "video server 12". To the extent that the Examiner really means "video server 12", his finding is incorrect as a matter of law, because claim 14 further limits the "identifying means", which has been found by the Examiner to be "control server 54" in his rejection of claim 11 from which claim 14 depends. The rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the "identifying means", which the Examiner has found to be embodied in control server 54 of Baker. In making his rejection the Examiner states:

Regarding claim 15, Baker discloses that video server 12 is a Unisys mainframe (column 8, lines 42-48).

This statement is legally irrelevant because it does not address the "identifying means" (found by the Examiner to be control server 54 of Baker) which is further limited by claim 15. Therefore, the rejection of claim 15 is respectfully traversed as legally irrelevant.

Claim 16 is an independent method claim. To make Applicants' invention more explicit, claim 16 has been slightly amended to require that the "transaction server" perform the "determining" and "assigning" steps. As explained above in detail, Baker explicitly teaches away from this method of operation. The rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and is further limited by a user function handled by the "transaction server". The Examiner ignores the claim limitation and rather cites Baker column 12, lines 7-17, which describes how video server 12 handles similar user functions. The rejection of claim 17 is respectfully traversed for failure of the Examiner to address the claimed invention.

Claim 18 depends from claim 17 and is further limited by a user function handled by the "transaction server". The Examiner ignores the claim limitation and rather cites Baker column 12, lines 7-17, which describes how video server 12 handles similar user functions. The rejection of claim 18 is respectfully

traversed for failure of the Examiner to address the claimed invention.

Claim 19 depends from claim 18 and is further limited by a user function handled by the "transaction server". The Examiner ignores the claim limitation and rather cites Baker column 16, lines 5-9, which requires that video server 12 handle such user functions. The rejection of claim 19 is respectfully traversed for failure of the Examiner to address the claimed invention.

Claim 20 depends from claim 19 and is further limited by a user function handled by the "transaction server". The Examiner ignores the claim limitation and rather cites Baker column 7, lines 33-51, which requires that video server 12 handle such user functions. The rejection of claim 20 is respectfully traversed for failure of the Examiner to address the claimed invention.

In rejecting independent apparatus claim 21, the Examiner repeats the clearly erroneous findings identified above in stating:

....wherein said software controlled transaction server 54 spools a requested on of said plurality of video programs....

As explained above in detail, Baker teaches that video server 12 both "spools" the program and "streams" the program. Baker has no discussion about any "software" of "control server" 54. The rejection of claim 21, and all claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings

of fact.

Claim 22 depends from claim 21 and further limits the "software controlled transaction server" in accordance with the handling of video programming data. As explained above in detail, Baker teaches that video programming data is handled only by video server 12. The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and further limits the distribution system. Because Baker cannot meet all of the limitations of claim 22 from which claim 23 depends, it cannot meet the limitations of claim 23 including these additional unique limitations. The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and further limits the user request system. Because Baker cannot meet all of the limitations of claim 23 from which claim 24 depends, it cannot meet the limitations of claim 24 including these additional unique limitations. The rejection of claim 24 is respectfully traversed.

Claims 2-5 and 7-10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of U.S. Patent No. 5,826,085, issued to Bennett et al (hereinafter referred to as "Bennett"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie*

case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, which is the burden of the Examiner under MPEP 2143, he must show 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make these required showings.

Claim 2 depends from claim 1 and further limits the software architecture of the transaction server. The Examiner admits that Baker does not have the limitations of claim 2. He somehow finds that Bennett has these limitations without having the architecture of Baker or Applicants' claimed invention.

With regard to motivation, the Examiner states:

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Baker to utilize the middleware environment of Bennett thus enabling applications on different machines to be seamlessly interconnected. (Emphasis added)

This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembicza*k, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

Furthermore, the system taught by Baker already "enables applications on different machines to be seamlessly interconnected". Baker states at column 4, lines 53-57:

The present invention surpasses these prior art systems

by fully utilizing the improved capabilities of large enterprise servers such as the 2200 Series computers available from Unisys Corporation to selectively distribute full-motion digital video data on demand to more viewers.

Those of skill in the art would appreciate that this preferred architecture "enables applications on different machines to be seamlessly interconnected".

Applicants have previously made this argument. In response thereto, the Examiner states in the pending official action:

Bennet (sic) is cited merely to teach the use of a middleware environment in a VOD type server.

This response specifically highlights the inadequacy of the Examiner's attempt to show motivation. To say that the acknowledged missing claim element simply exists as proven by Bennett, does not explain why someone would be motivated to make the alleged combination as required by controlling law.

Because Baker already provides the function, one would not be motivated to combine Bennett with Baker to duplicate the functions already found within Baker. The rejection of claim 2 is respectfully traversed.

The Examiner completely ignores his obligation under MPEP 2143 to provide evidence and/or reasoning to show "likelihood of success" of the alleged combination.

Furthermore, the alleged combination does not meet all of the claimed limitations, because the Examiner bases his rejection on clearly erroneous findings of fact. The Examiner states:

Bennett discloses in Figure 2, a VOD system with a VOD server 234.... (emphasis added)

Anyone viewing Fig. 2 of Bennett will see that SERVICES 235 contains VIDEO ON DEMAND SERVICE 234 but shows no VOD "server".

The rejection of claim 2 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 3 depends from claim 2 and further limits the "transaction server". The Examiner makes the legally irrelevant statement that Baker shows the limitations relative to "video server 12". However, as the Examiner clearly admits, the alleged combination of Baker and Bennett does not show the limitation with regard to "control server 54" which the Examiner alleges to be the claimed "transaction server".

As a result, the Examiner previously attempted to take Official Notice of the limitation, because he has cited numerous references along with his numerous official actions, wherein none show the claimed limitation. Applicants respectfully traversed this taking of Official Notice under MPEP 2144. Instead of citing prior art to support his taking of Official Notice as required by law, the Examiner has simply withdrawn his taking of Official Notice without addressing the lack of showing the claimed element as required by law. The rejection of claim 3 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 4 depends from claim 3 and further limits the claimed "transaction server". In making his response, the Examiner makes the legally irrelevant statement:

Regarding claim 4, Baker discloses that video server 12 may be a Unisys mainframe system (column 8, lines 43-51).

This statement is legally irrelevant, because claim 4 further limits the "transaction server" which the Examiner has found to be "control server" 54. To assist the Examiner in this regard, claim 2 (from which claim 4 depends) has been amended to require a preferred architecture for the claimed video servers. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the "transaction server". In support of his rejection, the Examiner makes clearly erroneous findings of fact stating:

Regarding claim 5, Baker discloses that the transaction server may spool the video (column 8, line 61-column 9, line 3) and that the format can be MPEG 2 (column 7, lines 9-16). (emphasis added)

Again, the Examiner cites functions that Baker teaches should be performed by the video server, as if they were performed by a transaction server as claimed. Fig. 2 clearly shows that all of the structure and functionality cited by the Examiner to support his rejection resides within video server 12. The rejection of claim 5 is respectfully traversed.

Claim 7 depends from claim 6 and further limits the claimed "transaction server". In making his rejection, the Examiner

makes the legally irrelevant statement that Baker shows similar limitations with regard to video server 12. However, the Examiner makes no showing that the alleged combination meets the limitations as claimed. The rejection of claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and uniquely limits the transaction server. Without addressing these limitations, the Examiner simply states: "Regarding claim 8 see claim 2". Because claim 8 has different limitations and is of a different scope from claim 2, the rejection of claim 8 is inadequate. The rejection of claim 8 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness.

Claim 9 depends from claim 8 and further limits the "transaction server". In making his rejection, the Examiner again cites material from Baker which relates to video server 12. As a result, the Examiner bases his rejection of claim 9 upon clearly erroneous findings of fact. Baker does not disclose "spooling" by the alleged "transaction server" (i.e., control server 54). The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed "transaction server". The Examiner makes his rejection alleging that Baker teaches the same limitations with respect to video server 12. As a result, his findings are legally irrelevant, because they do not address the claimed invention. The rejection

of claim 10 is respectfully traversed.

Claim 25 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Bennett and further in view of U.S. Patent No. 6,878,881, issued to Wilcox (hereinafter referred to as "Wilcox"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as required by MPEP 2143.

In making his rejection, the Examiner concludes "motivation" rather than meeting his burden of presenting evidence and/or reasoning showing motivation. The Examiner completely ignores the requirement to show "reasonable likelihood of success". The rejection of claim 25 is respectfully traversed for failure to present a *prima facie* case of obviousness.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to
Deposit Account No. 14-0620.

Respectfully submitted,

Ralph E. Sipple et al.

By their attorney,



Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
55413
(612) 331-1464

Date October 12, 2005